

REMARKS/ARGUMENTS

Claims 1-44 were pending in the present application. By virtue of this response, claim 13 has been cancelled, claim 26 has been amended and no new claims have been added. Accordingly claims 1-12 and 14-44 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Rejections under 35 U.S.C. §102

Claims 1-44 are rejected as allegedly being anticipated by Shimbo et al. U.S. Patent No. 6,092,191 (hereinafter Shimbo).

In particular, the Office Action asserts that the elements of “intercepting a request to establish a connection with the second computer sent by the first computer”, establishing a connection with the second computer and with the first computer”, “receiving a request for the first content sent by the first computer”, and “send the request for the first content to the second computer” of claim 1 of the present application are disclosed by Shimbo at col. 3, line 43 to col. 4, line 3. Shimbo discloses a method for transferring a packet from a source computer to a destination computer in a network system. A packet is transmitted by a source computer from a source side packet processing device to an adjacent packet processing device after attaching an end-to-end authentication data and a link-by-link authentication data. The link-by-link authentication data is inspected at least one intermediate packet processing device and, when authenticated, the packet is transferred to a next packet processing device. The end-to-end authentication data is inspected at the destination side packet processing device and transferred to the destination computer when the packet is authenticated.

The Office Action then asserts that the elements of “receiving a response from the second computer containing the first content” and “sending the first content and the second content to the first computer” are disclosed by Shimbo at col. 5, lines 58 through col. 6 line 32. Here Shimbo discloses a method for decrypting a packet at a packet processing device including storing

an address information for computers which are managed by the packet processing device, judging whether a destination computer of a packet of a passing packet is one of the computers which is managed by the packet processing device, and decrypting a data portion of the packet when the destination computer of the packet is judged as one of the computers which are directly managed by the packet processing device.

Applicant respectfully traverses this rejection. There are a number of elements of claim 1 not disclosed by Shimbo. The method and apparatus of Shimbo operates on a "packet". Nowhere does Shimbo disclose "intercepting a request to establish a connection with a second computer", a "receiving a request for the first content sent by the first computer", or "receiving a response from the second computer containing the first content". Even if it were asserted that the packet operated on by Shimbo includes one of the "request to establish a connection with a second computer", "request for the first content sent by the first computer", or "a response from the second computer containing the first content", which Applicant asserts it does not, Shimbo only operates on a single packet. Thus, Shimbo could not possibly disclose all three elements. In short, claim 1 recites all three of a "request to establish a connection", a "request for the first content", and a "response from the second computer containing the first content" while Shimbo only discloses a single packet of no particular type. Put another way, claim 1 requires "intercepting a request to establish a connection", "receiving a request for . . . content", and "receiving a response . . . containing the first content". Even if each of these distinct elements were asserted to be disclosed by a "packet", the method and apparatus of Shimbo only operate on a single packet, not three distinct packets. And, nowhere does Shimbo disclose the nature of this packet to be to establish a connection, request content or contain content. Thus, because claim 1 includes elements not disclosed by Shimbo, claim 1 cannot be anticipated by Shimbo and Applicant respectfully requests withdrawal of this rejection.

Claims 2-6 are each dependent on claim 1. Thus, neither can Shimbo anticipate claims 2-6 and 26. Applicant respectfully requests withdrawal of these rejections.

Claim 7 recites a method for inserting second content into first content requested over the internet including at least "receiving a request for the first content sent by the first computer"

and “receiving a response from the second computer containing the first content”. Nowhere does Shimbo disclose receiving a request for first content or receiving a response containing first content. As discussed above, Shimbo only discloses an apparatus and method for operating on a non-specific packet. Shimbo does not disclose a request for first content or response containing first content. Additionally, also as discussed above, Shimbo operates on a single packet, not two distinct pieces of information from two different sources. Thus, claim 7 includes elements not disclosed by Shimbo and Shimbo cannot anticipate claim 7. Applicant respectfully requests withdrawal of this rejection.

Claims 8-12 are each dependent on claim 1. Thus, neither can Shimbo anticipate claims 8-12. Applicant respectfully requests withdrawal of these rejections.

Claim 13 has been cancelled.

Claim 14 recites a method for inserting second content into first content requested over the Internet by a first computer including at least “steps for receiving a request for the first content sent by the first computer” and steps for receiving a response from the second computer containing the first content”. As discussed above, the method and apparatus of Shimbo operate on only a single packet. Nowhere does Shimbo disclose a “request for. . . first content” or a “response . . . containing the first content”. Additionally, even if it were asserted that the packet of Shimbo disclosed a request for first content, which Applicant believes it does not, Shimbo could at most disclose a request from a first computer or a response from a second computer, but not both because Shimbo discloses only a single packet. Accordingly, because Shimbo does not disclose elements recited in claims 14, Shimbo cannot anticipate claim 14 and Applicant respectfully requests withdrawal of this rejection.

Claims 15-19 are each dependent on claim 14. Thus, neither can Shimbo anticipate claims 15-19 and Applicant respectfully requests withdrawal of these rejections.

Claim 20 recites a device for inserting second content into first content requested over the Internet by a first computer from a second computer including at least “means for receiving a request for the first content sent by the first computer” and “means for receiving a response from the

second computer containing the first content”. As discussed above, because Shimbo discloses only a single, non-specific packet, and not a request for first content or a response containing the first content, Shimbo cannot anticipate claim 20.

Claims 21-25 are each dependent on claim 20 and claim 26 has been amended to depend from claim 20. Thus, neither can Shimbo anticipate claims 21-26 and Applicant respectfully requests withdrawal of these rejections.

Claim 27 recites a method for delivering second content to a first computer that has requested first content over the Internet from a second computer before the first computer receives the first content including at least “intercepting a request to establish a connection”, “receiving a request for the first content”, “receiving a re-request for the first content” and “receiving the first content from the second computer”. As discussed above, Shimbo discloses a method and apparatus that operate only on a single, non-specific packet. Thus, Shimbo cannot disclose “intercepting a request to establish a connection”, “receiving a request for the first content”, “receiving a re-request for the first content” or “receiving the first content from the second computer”. Accordingly, Shimbo cannot anticipate claim 27 and Applicant respectfully requests a withdrawal of this rejection.

Claims 28 and 29 are each dependent on claim 27. Thus, neither can Shimbo anticipate claims 28 and 29 and Applicant respectfully requests withdrawal of these rejections.

Claim 30 recites a device for delivering second content to a first computer that has requested first content over the Internet from a second computer before the first computer receives the first content including “a request to establish a connection with the second computer”, “a request for the first content sent by the first computer”, “a re-request for the first content”, and “means for requesting the first content”. As discussed above, Shimbo discloses a method and apparatus that operate only on a single, non-specific packet. Thus, Shimbo cannot disclose “a request to establish a connection with the second computer”, “a request for the first content sent by the first computer”, “a re-request for the first content”, or “means for requesting the first content”. Accordingly,

Shimbo cannot anticipate claim 30 and Applicant respectfully requests a withdrawal of this rejection.

Claims 31-33 are each dependent on claim 30. Thus, neither can Shimbo anticipate claims 31-33 and Applicant respectfully requests withdrawal of these rejections.

Claim 34 recites a device for inserting second content into first content requested over the Internet including at least a “forwarding means for checking for first criteria in the request for first content, communicating information associated with the request for first content to a filtering means if the first criteria matches first pre-determined criteria . . . the filtering means for checking for second criteria in the request for first content, communicating information associated with the request for first content to a content insertion means if the second criteria matches second pre-determined criteria. . . .”

There are a number of elements of claim 34 not disclosed by Shimbo. Shimbo discloses a packet processing device for encrypting a packet including a checking means for checking an encryption information and a presence/absence of a signature information in a packet passing through the packet processing device. (Shimbo, col. 6, lines 50-59). Nowhere, however, does Shimbo disclose a request for first content. Neither does Shimbo disclose a forwarding means that communicates information to a filtering means nor a separate filtering means that checks for second criteria and communicates information to a content insertion means. Accordingly, Shimbo cannot anticipate claim 34 and Applicant respectfully requests withdrawal of this rejection.

Claim 35 recites a device for inserting second content into first content requested over the Internet by a first computer from a second computer including at least “means for receiving a response sent by the second computer responsive to the request for first content” and a “forwarding means for checking for first criteria in the response communicating information . . . to a filtering means . . . the filter means being for checking for second criteria in the response, communication information associated with the response to a content insertion means if the second criteria matches second pre-determined criteria. . . .”

There are a number of elements of claim 35 not disclosed by Shimbo. Shimbo discloses a packet processing device for encrypting a packet including a checking means for checking an encryption information and a presence/absence of a signature information in a packet passing through the packet processing device. (Shimbo, col. 6, lines 50-59). Nowhere, however, does Shimbo disclose a request for first content or a response to the request for first content. Neither does Shimbo disclose a forwarding means that communicates information to a filtering means nor a separate filtering means that checks for second criteria and communicates information to a content insertion means. Accordingly, Shimbo cannot anticipate claim 35 and Applicant respectfully requests withdrawal of this rejection.

Claim 36 recites a method for modifying first content request over the Internet by a first computer from a second computer including at least “receiving a request for the first content” and receiving a response . . . containing the first content” As discussed above, Shimbo discloses a method and apparatus that operate only on a single, non-specific packet. Thus, Shimbo cannot disclose receiving a request for first content or receiving a response containing the first content. Accordingly, Shimbo cannot anticipate claim 36 and Applicant respectfully requests a withdrawal of this rejection.

Claims 37-41 are each dependent on claim 36. Thus, neither can Shimbo anticipate claims 37-41 and Applicant respectfully requests withdrawal of these rejections.

Claim 42 recites a method for modifying a request for first content being requested over the Internet including at least “receiving the request for the first content . . . modifying the request for first content . . . and sending the modified request to the second computer or to another computer.” As discussed above, Shimbo discloses a method and apparatus that operate only on a non-specific packet. Thus, Shimbo cannot disclose receiving a request for first content. Accordingly, Shimbo cannot anticipate claim 42 and Applicant respectfully requests a withdrawal of this rejection.

Claims 43 and 44 are each dependent on claim 42. Thus, neither can Shimbo anticipate claims 43 and 44 and Applicant respectfully requests withdrawal of these rejections.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **495142000100**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 7, 2004

Respectfully submitted,

By 

Douglas G. Hodder

Registration No.: 41,840

MORRISON & FOERSTER LLP

755 Page Mill Road

Palo Alto, California 94304

(650) 813-4203